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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,880	01/30/2001	Hiroshi Hagane	Q62767	2676

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

LELE, TANMAY S

ART UNIT	PAPER NUMBER
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2684

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DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/771,880

Applicant(s)

HAGANE, HIROSHI

Examiner

Tanmay S Lele

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-18.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Tanmay Lele
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DETAILED ACTION

Response to Arguments

1. In response to applicant's argument that "Chen does not disclose, teach or suggest packet communication based on speech recognition for sending and receiving at least one of image information and character information by performing packet communication with the center, as recited in Applicant's independent claims 1, 11, 13 and 18," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In regards to claims 1, 11, 13, and 18, Applicant attempts to overcome the rejection by stating, While, as noted by the Examiner, Chen discloses that the desired information can be delivered to the user "in the appropriate voice and/or text format" (see *Id.*, col. 6, lines 36-39; see also *Id.*, col. 5, lines 9-19), Chen does not disclose, teach or suggest packet communication based on speech recognition for sending and receiving at least one of image information and character information by performing packet communication with the center, as recited in Applicant's independent claims 1, 11, 13 and 18. That is, Chen discloses packet communication only in the context of "wireless packet services" where "the user need not establish a traditional phone call to extract simple information from the Internet" (see *Id.*, col. 5, lines 24-27; and col. 5, line 48 through col. 6, line 13). Thus, Chen teaches away from performing packet communication in

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conjunction with speech communication, let alone: in conjunction with speech recognition, as recited in Applicant's independent claims 1, 11, 13 and 18" (that this language was not noted in all claims, as an example claim 11). Examiner again respectfully disagrees that Chen does not teach of teaching the claimed as broadly interpreted. Note that Chen, in addition to teaching the sections by Applicant (paper 10, page 3), also notes, "The extracted information is then converted via user presentation software to the appropriate end user related protocol..." (column 5, lines 9 – 16). Continuing as noted by Applicant, Chen states the use of SMS (short messaging services), which as known in the art are packets of data (7 bit ASCII characters) that can be transmitted simultaneously with voice traffic (as noted in texts, for example Rappaport's Wireless Communications). Chen further makes note of other standards (column 5, lines 28 – 35) and thus as such concepts are known in the art, it is reverently believed Chen does not teach away from performing, "packet communication in conjunction with speech communications," as noted by Applicant. Hence, because the Examiner is required to interpret the claims in the broadest reasonable manner under current examining practice, the Examiner is not persuaded by the Applicant's arguments that the cited references do not teach or recite the claimed as broadly interpreted.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, with regards to claims 1, 11, 13, and 18, Applicant attempts to overcome the rejection by stating, "As noted in Applicant's previous Amendment, Toru discloses a method wherein an HTML sentence data obtained as a search result is returned in response to a voice request from a mobile terminal user," and further that "On the other hand, as further noted in Applicant's previous Amendment, an objective of Chen's invention is to eliminate the need for providing HTML links (see Chen, col. 1, line 39 through col., 2, line 5). Thus, considering each disclosure, Chen and Toru, in its entirety, the combination of Chen and Toru is improper."

Examiner respectfully disagrees with Applicant's argument that the disclosures are opposing and further that the combination is not proper. Note that Toru teaches of HTML text data is displayed (paragraph 0014) and further that the page can be browsed (paragraph 0032) based on a voice request (paragraph 0032 and 0055 for example). Note that these features are developed in Chen, where web pages can be viewed or heard on different apparatus (column 5, lines 14 –39 for example) as prescribed by a user (column 5, lines 3 –16 and again in column 5, lines 22 –35).

Thus, Toru provides more than an HTML link as noted above. Further it is respectfully believed that use of Chen's methods for viewing or hearing data as per the terminal constraints in view of Toru's searching (if for example it were to be assumed that Toru only outputted the HTML link) would still be within the bounds of both disclosures. Hence, Examiner is not persuaded by Applicant's arguments that combination improper and respectfully believes that the combination, combined for the cited motivation, teach or recite the claimed as broadly interpreted.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., packet communication based on speech recognition for sending and receiving at least one of image

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information and character information by performing packet communication with the center, as recited in Applicant's independent claim 11) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 11, Applicant attempts to overcome the rejection by stating, "Chen does not disclose, teach or suggest packet communication based on speech recognition for sending and receiving at least one of image information and character information by performing packet communication with the center, as recited in Applicant's independent claim 11." Note that this language was not noted in the claims as presented and hence Examiner is not persuaded by Applicant's arguments that the cited references, when combined, do not teach or recite the claimed as presented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanmay S Lele whose telephone number is (703) 305-3462. The examiner can normally be reached on 9 - 6:30 PM Monday – Thursdays and on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A. Maung can be reached on (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.


Tanmay S Lele
Examiner
Art Unit 2684

tsl
June 7, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER